

REMARKS

The applicants respectfully request reconsideration in view of the amendment and the following remarks. The applicants have amended claims 1 and 15 as suggested by the Examiner. The term “colorant” is disclosed e.g. in the specification on page 5 lines 9-11, 13-18, 25-32 and in claim 2. The applicants have clarified the term “VDA 275”. VDA 275 is not a trademark or trade name, it is a reference which describes a standardized method for the determination of formaldehyde emission (see page 7 lines 2-7 of the specification).

Claims 1, 15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12, 13, 19, 20, and 23 contain the trademark/trade name VDA 274. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pitt et al. U.S. Patent No. 5,476,653 (“Pitt”). Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt or Muck et al. U.S. Patent No. 5,994,455 (“Muck”). Claims 2, 3, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt or Muck as applied to claim 1 above, and further in view of Kosinski EP 448037 and Chapman et al. U.S. Patent No. 3,656,982 (“Chapman”). Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muck or Pitt as applied to claim 1 above, and further in view of Yokoyama et al. U.S. Patent No. 5,952,410 (“Yokoyama”). Claims 15-18, 21, 22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muck or Pitt each in view of Kosinski et al. U.S. Patent No. 5,952,410, Chapman and Yokoyama. The applicants respectfully traverse these rejections.

35 U.S.C. 112, Second Paragraph Rejection

Claims 1, 15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicants believe that the claims as amended are in compliance with 35 U.S.C. 112 second paragraph.

Claims 12, 13, 19, 20, and 23 contain the trademark/trade name VDA 274. Again, as stated above, the term “VDA 275” is not a trademark or trade name, it is a reference which describes a standardized method for the determination of formaldehyde emission (see page 7 lines 2-7 of the specification). However, the applicants have clarified the phrase “VDA 275” to “wherein the formaldehyde emission determined in accordance with the German Automotive Industry Recommendation No. 275 (VDA 275)”. For the above reasons, this rejection should be withdrawn.

Rejection over Pitt

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pitt. Pitt describes biomolecules linked to one or more chains of a synthetic polymer consisting of chains of oxymethylene and oxyethylene groups (column 4 lines 54-58). For the preparation of the synthetic polymer trifluormethylsulfonic acid is used (column 5 lines 42-47). In contrary to the amended claim 1 of the present invention, Pitt does not describe a polyacetal molding composition containing colorants. Therefore, claim 1 is novel in view of Pitt .

35 U.S.C. § 103(a)Rejection

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt or Muck. Claims 2, 3, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt or Muck

as applied to claim 1 above, and further in view of Kosinski EP 448037 and Chapman. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muck or Pitt as applied to claim 1 above, and further in view of Yokoyama. Claims 15-18, 21, 22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muck or Pitt each in view of Kosinski, Chapman and Yokoyama.

The increased level of formaldehyde emission of synthetic copolymers containing oxymethylene and oxyethylene units if a colorant (pigment) is mixed with said copolymers is well known (see e.g. present application page 3 lines 17-21).

The object of the applicants' claimed invention was to develop colored POM molding compositions in which the formaldehyde emission observed hitherto has been substantially reduced, without impairing the known advantageous properties of POM. (see the specification at page 3, lines 22-25).

Pitt and Mück describe oxymethylene/oxyethylene copolymers. As the Examiner has recognized neither Pitt nor Mück described compositions that contain colorants (see the middle of paragraph no. 8 in the middle of page 4 of the Office Action).

The oxymethylene/oxyethylene copolymers can be prepared with several alternative initiators (e.g. with Lewis acids, see Mück column 1 lines 35-39). There is no evidence in Pitt or Mück that copolymers containing oxymethylene and oxyethylene units and a colorant (pigment) leads to an increased formaldehyde emission and that this emission can be reduced by mixing specific prepared copolymers (with a strong protonic acid) with the colorant (pigment). For example, the preparation of the copolymers with Lewis acids (described in Mück) leads to a

higher formaldehyde emission (see e.g. present application comparative examples, wherein the copolymer is prepared with BF₃ (page 8 line 1, results page 10 table 1).

Kosinski describes polyacetal compositions which can comprise colorants / pigments (page 12 lines 29-34). The increased formaldehyde emission of colored oxymethylene/oxyethylene copolymers is not discussed nor are corresponding polymer compositions explicitly described in the examples. In contrast to the present application, Kosinski describes mixtures of the polymer with hindered amines as light stabilizer as necessary limitation. Further a person of ordinary skill in the art couldn't find any evidence in Pitt, Mück or Kosinski to prepare copolymers containing oxymethylene and oxyethylene units mixed with a colorant (pigment), wherein the copolymer is prepared with a strong protonic acid to reduce the formaldehyde emission of the resulting colored copolymer compound.

Chapman describes only some pearlescent pigments for cosmetically usage (e.g. abstract). There are no compositions described which encompasses oxymethylene/oxyethylene copolymers. In addition, there is no indication given which kind of oxymethylene/oxyethylene copolymers has to be used for the reduction of the formaldehyde emission raised through the mixture of said copolymer with a colorant (pigment).

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re

Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2d. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Muck or Pitt each in view of Kosinski, Chapman and Yokoyama.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

A two month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05587-00327-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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